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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,872	03/12/2001	William Coan	12177/44301	5649
23838	7590	04/04/2005	EXAMINER	
KENYON & KENYON 1500 K STREET, N.W., SUITE 700 WASHINGTON, DC 20005			ESCALANTE, OVIDIO	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/802,872

Applicant(s)

COAN ET AL.

Examiner

Ovidio Escalante

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 03 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) a set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: \_\_\_\_\_.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

**OVIDIO ESCALANTE  
PATENT EXAMINER**

*Ovidio Escalante*

**FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600**

*[Signature]*

***Advisory Action***

***As per claim 1:***

Applicants assert that Dusse does not disclose at least searching the mobile communication device for the requested sub-feature. Applicants argue that Dusse would not need to search the mobile communication device for a requested sub-feature since Dusse is only concerned with the initial provisioning of mobile devices. The Examiner respectfully disagrees.

As correctly noted by the Applicants, Dusse relates to an initial provisioning of a mobile device that does not have features or services installed. A user will activate the phone and will provision the phone with services and features that they desire. Initially when the phone is first activated all of the available services and features will be listed for the user. Dusse states in paragraph 0045 that after the initial services have been provisioned a user may make changes to the features or services at any time. The mobile device of Dusse is able to determine what needs to be provisioned and what has already been provisioned. Based on this teaching the mobile phone of Dusse must inherently search the mobile phone for features and services that have been already provisioned and features and services that are not yet provisioned. Thus when a user accesses the services and features, the mobile phone searches for the requested feature so that it can determine whether or not it needs to go to an external server or whether the feature or service has already been initialized.

***As per claim 12:***

Applicants further assert that Dusse does not disclose at least receiving, at the mobile communication device, a command to access said first service and responsive to said command, determining whether said first set of features can satisfy said command. Applicants argued that

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Dusse would have no need to determine whether a first set of features on a mobile device can satisfy a command to access a first service, because Dusse has already discloses that any previously installed applications are non-operational and require provisioning. The Examiner respectfully disagrees.

As stated above, Dusse states in paragraph 0045 that after the initial services have been provisioned a user may make changes to the features or services at any time. Thus when a user makes a request the mobile phone must determine whether or not the requested features has already been provisioned or has not yet been provisioned. Therefore, if the mobile phone is already provisioned then the command to access a first service is satisfied.

***As per claim 24:***

Applicants assert that Dusse does not disclose at least a mobile communication device [having] a program to perform the operations of ... determining whether said communication service can be satisfied by the mobile communication device as a stand alone device. Applicants argue that the Office's assertion that a server is making an initial determination is off-point and has no bearing on the claimed invention and that the Office's assertion that once the user selects the appropriate feature and service the it is determined that the mobile device can act as a stand-alone device also has not bearing on the claimed invention. The Examiner respectfully disagrees.

As stated above, the mobile device of Dusse provides for the provision of services and features of the telephone. Initially the server determines that most of the communication services or features cannot be satisfied by the mobile device as a stand alone device and if the user wants to use the features and services of the mobile device the user must make a request for desired services and features. When a user makes a request, all of the selections that will shown in the

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provisioning screen are determined to be services and features that the user can have on their phone. Therefore, once the user selects the appropriate features and services then it is determined that the mobile device can act as a stand-alone device.